

ESTTA Tracking number: **ESTTA317958**

Filing date: **11/20/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	New York Yankees Partnership
Granted to Date of previous extension	11/22/2009
Address	Executive Offices, Yankee Stadium One East 161st Street Bronx, NY 10451 UNITED STATES
Attorney information	Maryann E. Licciardi Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES mel@cll.com, trademark@cll.com Phone:212-790-9200

Applicant Information

Application No	76691096	Publication date	05/26/2009
Opposition Filing Date	11/20/2009	Opposition Period Ends	11/22/2009
Applicant	Evil Enterprises, Inc. PO Box 2038 Bridgehampton, NY 11932 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: clothing, namely, shirts, t-shirts, sweatshirts, jackets, pants, shorts and hats

Grounds for Opposition

Other	See attached pleading.
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Attachments	BASEBALLS EVIL EMPIRE - Letter to Commissioner.pdf (1 page)(80996 bytes) BASEBALLS EVIL EMPIRE - Notice of Opposition.pdf (8 pages)(55376 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Maryann E. Licciardi/
Name	Maryann E. Licciardi
Date	11/20/2009

Cowan, Liebowitz & Latman, P.C.

Law Offices

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November 20, 2009

By Electronic Filing

Commissioner for Trademarks
Attn: TTAB
P.O. Box 1451
Alexandria, VA 22313-1451

Re: New York Yankees Partnership
Notice of Opposition Against
Evil Enterprises, Inc.'s
Application to Register BASEBALLS EVIL EMPIRE
Attorney Ref. No. 21307.033

Dear Commissioner:

We enclose a Notice of Opposition against Application Serial Number 76/691,096 published in the Official Gazette on May 26, 2009. Contemporaneously with the electronic filing of this Notice of Opposition, we are arranging for an electronic payment in the amount of \$300 to cover the filing fee.

If the amount received is insufficient and additional fees are required, please charge our Deposit Account No. 03-3415.

Please address all future correspondence to the attention of Mary L. Kevlin, Esq. of Cowan, Liebowitz & Latman, P.C.

Respectfully submitted,

/Maryann E. Licciardi/

Maryann E. Licciardi

Enclosures

cc: Diane Kovach (w/encs. – by email)
Mary L. Kevlin, Esq. (w/encs.)
Richard S. Mandel, Esq. (w/encs.)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 76/691,096
Filed: July 7, 2008
For Mark: BASEBALLS EVIL EMPIRE
Published in the Official Gazette: May 26, 2009

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NEW YORK YANKEES PARTNERSHIP,

Opposer,

v.

EVIL ENTERPRISES, INC.,

Applicant.
-----X

NOTICE OF OPPOSITION

Opposition No.

Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Opposer New York Yankees Partnership, an Ohio limited partnership with offices at Executive Offices, Yankee Stadium, One East 161st Street, Bronx, New York 10451 (“Opposer”) believes that it will be damaged by registration of the standard character word mark BASEBALLS EVIL EMPIRE in International Class 25 for “clothing, namely, shirts, t-shirts, sweatshirts, jackets, pants, shorts and hats” as shown in Application Serial No. 76/691,096 (the “Application”) and, having been granted extensions of time to oppose up to and including November 22, 2009, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Opposer is the owner of the renowned NEW YORK YANKEES MAJOR LEAGUE BASEBALL club (the “Club”).

2. The Club is one of the most successful sports franchises in the history of the United States with forty appearances in annual WORLD SERIES CHAMPIONSHIP games and twenty-seven WORLD SERIES titles. In addition to its sports entertainment services, the Club is now and long has been widely known in the United States for its wide variety of merchandise, including, but not limited to, shirts, T-shirts, sweatshirts, jackets, pants, shorts, hats and other apparel.

3. Opposer, its predecessors, and their affiliated and related entities, licensees and/or sponsors have used, and have promoted and advertised the sale and distribution of goods and services bearing or offered in connection with, various names, marks and domain names comprising or containing YANKEES, NEW YORK YANKEES and various NY designs, alone or with other words, letters or designs, in connection with baseball games and exhibition services and a wide variety of goods and services, including, but not limited to, shirts, T-shirts, sweatshirts, jackets, pants, shorts, hats and other apparel. Opposer and its MINOR LEAGUE BASEBALL affiliates have, for decades, used such marks and logos as primary source identifiers, including, without limitation, the interlocking letters “NY” which often appear in the color blue, alone or with other word, letter and/or design elements including, without limitation,



as shown here: (the “Yankees NY Marks”), and including, without limitation, a top hat design featuring horizontal stars and vertical stripes wherein the stars often appear in white on a blue background and the stripes often appear in red and white, and wherein the inside lip of the top hat often appears in white, resting on a baseball bat, alone or with other word, letter and/or



design elements, including, without limitation, as shown here: (the “Yankees Top Hat Marks”). Opposer owns U.S. federal registrations and applications for the Yankees NY Marks and the Yankees Top Hat Marks in International Classes 6, 9, 11, 14, 16, 18, 20, 21, 24, 25, 26, 28, 30, 34 and 41; namely, Registration Nos. 1,076,665, 1,182,757, 1,564,580, 1,577,279, 1,898,998, 2,309,488, 2,368,952, 2,651,320, 3,320,066, 3,320,067, 3,331,057, 3,331,058, 3,412,814, 3,593,130, 1,032,767, 2,575,644, 3,320,068, 3,320,069 and 3,320,070. Registration Nos. 1,076,665, 1,182,757, 1,564,580, 1,577,279, 1,898,998, 2,309,488, 2,368,952, 2,651,320, 1,032,767 and 2,575,644 are incontestable.

4. Since long prior to July 7, 2008, Applicant’s constructive first use date, because of the Club’s successes, including its outstanding record in MAJOR LEAGUE BASEBALL competitions and WORLD SERIES titles, and its relatively lucrative player contracts, Opposer has been commonly and extensively referred to by the press, media, fans and the public by the designation the “Evil Empire” in addition to its names NEW YORK YANKEES and YANKEES. The “Evil Empire” designation was originally coined by the CEO of the BOSTON RED SOX club, an arch rival of the YANKEES Club, as a derogatory reference to Opposer.

5. Major League Baseball Properties, Inc. (“MLBP”) (which is indirectly wholly owned by the thirty Major League Baseball clubs (the “MLB Clubs”), including, without limitation, Opposer, and which is the licensing agent for all of the MLB Clubs, including Opposer), and its affiliated and related entities, including the Office of the Commissioner of Baseball and the MLB Clubs (including Opposer), have long used marks that comprise or contain the words MAJOR LEAGUE BASEBALL, BASEBALL and/or BEISBOL, in connection with their baseball game and exhibition services and a wide variety of goods and

services, including, without limitation, clothing. MLBP and the other MLB entities, including the Club, are recognized and referred to by fans, the press, media and public alike interchangeably as MAJOR LEAGUE BASEBALL and BASEBALL.

6. On July 7, 2008, Applicant filed the Application for the standard character word mark BASEBALLS EVIL EMPIRE for “clothing, namely, shirts, t-shirts, sweatshirts, jackets, pants, shorts and hats,” based on an intent to use.

7. Upon information and belief, Applicant did not use the BASEBALLS EVIL EMPIRE mark for the goods covered in the Application in United States commerce prior to its constructive first use date of July 7, 2008.

8. Applicant’s mark, which combines the word BASEBALLS (a word which in this context is a shortened form understood to mean MAJOR LEAGUE BASEBALL) with the words EVIL EMPIRE, a designation that refers to and is widely understood to identify the Club, uniquely points to the Club.

9. The term “evil empire” has a negative connotation because the word “evil” refers to that which is morally wrong or bad, immoral, wicked, harmful and/or injurious. The BASEBALLS EVIL EMPIRE mark will be understood to refer to the Club, and, upon information and belief, is clearly intended to do so, and thus may disparage Opposer, or bring Opposer into contempt or disrepute among a significant segment of the consuming public.

10. Moreover, alternatively, certain Yankees fans have embraced the “Evil Empire” designation, viewing it as a badge of honor reflecting the Club’s success, and other supporters in the press and media have also made ongoing use of the designation EVIL EMPIRE to identify the Club and tout its accomplishments. This widespread public usage of the designation EVIL EMPIRE, alone and with other words conjuring up a force to be reckoned with, such as “EVIL EMPIRE STRIKES BACK,” inures to the benefit of the Club as significant usage on its behalf.

Applicant's BASEBALLS EVIL EMPIRE mark thus is likely to cause confusion because it so resembles the "Evil Empire" designation, as to be likely, when used in connection with Applicant's goods, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's goods, which are identical and/or closely related to the goods offered and services rendered in connection with the Club's marks, have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would thereby be injured by the granting to Applicant of a certificate of registration for Applicant's BASEBALLS EVIL EMPIRE mark.

11. Opposer would be further injured by the granting of a certificate of registration to Applicant because Applicant's BASEBALLS EVIL EMPIRE mark would falsely suggest a connection between Applicant and Opposer.

12. Applicant's intent to trade on the goodwill of Opposer is made clear by its use on Applicant's website www.baseballsevillempire.com and on the goods being sold or offered for sale on that site which feature the term "Baseballs Evil Empire" in connection with designs that are highly similar to the Yankees NY Marks and the Yankees Top Hat Marks, as shown by comparison below:

Opposer's Mark



Mark Used on Applicant's Website:



Opposer's Mark:



Mark Used on Applicant's Website:



As shown above, Applicant uses marks on its website and on its products that appear in the same color blue and in the same position as the Yankees NY Marks, but with a devil face resting in the arms of the letter “Y” (as shown above), and with designs that are virtually identical to the Yankees Top Hat Marks, namely, four identically proportioned horizontal stars on an identical top hat rim on a bat at the precise angle as in the Yankees Top Hat Marks, wherein the four stars appear in white on a same blue background, and wherein the inside lip of the top hat appears in white, resting on the bottom half of a bat of a similar size and shape as the baseball bat appearing in the Yankees Top Hat Marks (as shown above).

13. Indeed, Applicant’s bad faith intent to trade on Opposer’s goodwill is evidenced by the fact that Applicant’s website, which is geared toward Opposer’s fans, contains marketing statements such as: “The one source for all the latest tee-shirts and hats for all the Yankee fans around the world.”

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant’s BASEBALLS EVIL EMPIRE mark and requests that the opposition be sustained and said registration be denied.

Please recognize as attorneys for Opposer in this proceeding Mary L. Kevlin, Richard S. Mandel and Maryann E. Licciardi (members of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Please address all communications to Mary L. Kevlin, Esq. at the address listed below.

Dated: New York, New York
November 20, 2009

Respectfully submitted,

COWAN LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Maryann E. Licciardi/
Mary L. Kevlin
Richard S. Mandel
Maryann E. Licciardi
1133 Avenue of the Americas
New York, New York 10036
(212) 790-9200

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on November 20, 2009, I caused a true and correct copy of the foregoing Notice of Opposition to be sent via First Class Mail, postage prepaid, to Applicant's Attorney of Record, Gerard F. Dunne, Esq., Law Offices Of Gerard F. Dunne, P.C., 156 5th Ave, Suite 1223, New York, New York 10010-7735.

Dated: New York, New York
November 20, 2009

/Maryann E. Licciardi/
Maryann E. Licciardi